

REMARKS

In the Office Action dated August 28, 2009, the Examiner: (1) afforded priority to USSN 60/502,050 but not USSN 60/426,137; (2) rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and (3) rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. In view of the foregoing, Applicants respond as follows:

1. Response to Priority Determination

On pages 2-3 of the Office Action, the Examiner asserted that priority application number 60/426,137 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. § 112 for one or more claims. She identified the limitation of “19-30 nucleotides” as allegedly not being supported by the specification. Applicants request that the Examiner reconsider this position. Page 9, line 27 of the ‘137 application recites that each siRNA (in that case within a pool) has 18-30 base pairs. Lines 30-31 on the same page recite that “preferably, at least 19 contiguous [bases] of the antisense strand will be 100% complementary to the mRNA.” In order for at least 19 bases to be complementary to the mRNA, the duplex must have at least 19 base pairs. Thus, because the specification provides support for the limitations of 18-30 base pairs and at least 19 base pairs, there is support for the limitation of 19-30 nucleotide bases, and priority should be afforded to November 14, 2002.

2. Response to Rejection under 35 U.S.C. § 112, ¶1

The Examiner rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, first paragraph. As the Examiner notes, this rejection revisits an issue that was addressed in Applicants’ response filed on December 3, 2007. Applicants respectfully disagree with the Examiner’s position for at least the reasons provided in that response, and submit that support is provided for the method as defined in reference to the antisense sequence.

Nevertheless, in order to further prosecution, Applicants have removed all criteria that explicitly reference the antisense strand. However, the removal of this criteria does not change the scope of the claims, as it is understood by persons of ordinary skill in the relevant art that the claimed method applies when the criteria are applied through the application of the complementary criteria to the antisense strand, which requires no more than a modification of the computer program to apply the criteria to the complementary strand based on known Watson-Crick base pairings. Support for the amendments contained in this communication may for example be found on page 22 line 32 – page 23, line 14 of the specification as filed. Similar claim language in which the 19 bases that are the subject of the criteria are referred to as the sense sequence, which is either coextensive with or part of a sense region that is 19-30 bases long, is used in co-pending application serial number 10/940,892.

3. Response to Rejection 35 U.S.C. § 112, ¶2

The Examiner rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, ¶2 as being indefinite. This rejection is based on the inclusion of references in the previously pending claim set to portions on the antisense strand. Because Applicants have amended the claim set to remove these references to the antisense strand, the rejection is now moot. However, as noted above, Applicants respectfully disagree with the Examiner with respect to the basis of the rejection and believe that the amendment contained herein does not change the scope of the claims.

Applicants submit that no fee is due with this filing, other than the fee for the petition of extension of time. However, if any fee is deemed necessary, Applicants authorize the Patent Office to charge the Deposit Account No. 11-0171 for any such sum.

Respectfully submitted,

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